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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/565,883 | 05/24/2006 | Peter Dahmen | 2400.0180000/RWE/L-Z | 8057 |

26111 7590 08/31/2009

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| EXAMINER | |
|---|---|
| HOLLOMAN, NANNETTE | |
| ART UNIT | PAPER NUMBER |
| 1612 | |
| MAIL DATE | DELIVERY MODE |
| 08/31/2009 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/565,883 | DAHMEN ET AL. | |
| | Examiner | Art Unit | |
| | NANNETTE HOLLOMAN | 1612 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *03 June 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1,3-5 and 8-10* is/are pending in the application.

4a) Of the above claim(s) *3-5 and 8* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,9 and 10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

**DETAILED ACTION**

Applicants' arguments, filed June 03, 2009, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

***Declaration***

The declaration under 37 CFR 1.132 filed June 03, 2009 is insufficient to overcome the rejection of claims 1-2 and 9-10 based upon Dutzmann et al. (US Patent No. 6,306,850) as set forth infra because:

Applicant discloses in the declaration filed June 03, 2009, that the test of *Leptosphaeria nodorum* on wheat plants and *Fusaruim graminearum* on barley treated with the claimed composition showed greater efficacy than that calculated by the Colby formula and those disclosed by Dutzmann.

The Examiner submits the alleged unexpected results do not appear to be supported. The *Leptosphaeria nodorum* test of Dutzmann gave a 100% efficacy with the use of the instant formulation (II) alone (column 43), therefore unexpected results is

not supported. In regard to the results of *Fusaruim graminearum* test, the results appear to be no more than an additive effect and therefore would be expected.

***Claim Rejections - 35 USC § 112 (New Rejection)***

***1st Paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 9 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation of "consisting essentially of" was not disclosed in the specification as originally filed or the claims and is therefore "new matter".

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***2nd Paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "consisting essentially of" fails to

contemplate the exclusion of any particular ingredients as implied therein and does not provide any criteria for determining if a given ingredient "materially affects the basic or novel characteristics of the invention". Therefore the phrase renders the claim indefinite.

***Claim Rejections - 35 USC § 103***

Claims 1 and 2 were rejected under 35 U.S.C. 103(a) as being unpatentable over Dutzmann et al. (US Patent No. 6,306,850). This rejection is maintained and further applied to new claims 9 and 10. Claim 2 has been cancelled.

***Applicant Arguments***

Applicant argues Dutzmann is silent regarding the ratio of fluoxastrobin to tebuconazole and further argues synergistic effects.

***Examiner's Response***

In regard to the ratio of fluoxastrobin to tebuconazole, the reference discloses the combination of at least one active compound indicating more than one compound may be used. Therefore a combination of more than one active compound would be obvious. Furthermore, the combination of the claimed ternary combination of fluoxastrobin (formula (I)), prothioconazole (formula (II)) and tebuconazole (formula (III)) would have a ratio of 0.1:1:0.1 to 50:1:20 based on the teaching of Dutzmann, which would give the ratio of fluoxastrobin to tebuconazole of 0.1:0.1 to 50:20.

The prior art discloses the ratio of formula (I) to (II) from 0.1:1 to 50:1 and formula (I) to (III) from 0.1:0.1 to 50:20. Thus, the prior art differs from the instant claims insofar as it does not disclose the particular endpoints recited therein, i.e. of formula (I) to (II) from 1:0.1 to 1:10 and formula (I) to (III) from 1:0.05 to 1:10. It is well-settled, however, that even a slight overlap in range establishes a *prima facie* case of obviousness. In re Peterson, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003). Accordingly, it since an overlap plainly exists here, it would have been obvious to have selected values within the overlap, consistent with the reasoning of the Peterson decision.

In regard to Applicant's synergistic effects, it appears the results are no more than additive. Specifically, comparing the results of the Table on page 9 of the instant specification to that of Dutzmann, the results for Dutzmann of the combination of claimed formula (II) and (III) resulted in an efficacy of 100% at the ratio of 1:1 and 1:3, therefore adding a third composition could not give anymore than the 100% received, therefore there is no support for synergism.

Even, assuming, purely *arguendo*, that unexpected results had been shown, Applicant's claims encompass a broader range than that shown in the Table on p. 9 of the instant specification and Tables 1 and 2 of the declaration, therefore the examples are not commensurate in scope with the instant claims.

***Conclusion***

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANNETTE HOLLOMAN whose telephone number is (571) 270-5231. The examiner can normally be reached on Mon-Fri 800am-500pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. H./
Examiner, Art Unit 1612

/Frederick Krass/

Supervisory Patent Examiner, Art Unit 1612